

priority to the instant application. Applicant respectfully requests reconsideration of the claimed invention in view of the foregoing amendments and the following remarks.

*Non Art-Related Remarks*

Election/Restriction

In Paper No. 9, paragraph 2, the Examiner withdrew claims 6-8, 10, 16-18, and 20-22 from further consideration as being drawn to a non-elected invention. The Examiner did not address whether claims 1 and 11 were also withdrawn, and also did not address the merits of these claims. Applicant respectfully requests clarification of the status of claims 1 and 11.

35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claim 23 under 35 U.S.C. § 112, second paragraph, as allegedly being unclear as to what is an “effect on said cells” or how such an effect may be monitored. Applicant respectfully submits that the foregoing amendments render this rejection moot.

The Examiner has also rejected claim 24, contending that it is unclear what type of phenotype is being monitored. Applicant respectfully traverses this rejection.

When determining definiteness, the proper standard to be applied is “whether one skilled in the art would understand the bounds of the claim when read in light of the specification.” *Credle v. Bond*, 30 USPQ2d 1911, 1919 (Fed. Cir. 1994). If so, 35 U.S.C. § 112, second paragraph, is satisfied. See *Miles Laboratories, Inc. v. Shandon, Inc.*, 27 USPQ2d 1123, 1127 (Fed. Cir. 1993) (“If the claims read in the light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.”) (emphasis added).

The specification defines the term “phenotype” on page 13, lines 16-26 as referring to the outward appearance of a cell or tissue or the function of a cell or tissue. Examples of suitable phenotypes are described in the specification, for example on page

13, line 10, through page 14, line 26, and page 23, lines 7-17, and include cell size, cell shape, cell proliferation, cell differentiation, cell survival, cell death, the utilization of a metabolic nutrient, and a catalytic activity such as a protein tyrosine kinase catalytic activity. Based on the teachings of the instant specification, the ordinarily skilled artisan would understand that comparing the phenotypes of two cells would involve comparing the appearance or function of the two cells.

Accordingly, the instant claims, when read in light of the specification, reasonably apprise those skilled in the art of the scope of the invention with regard to the term “phenotype,” thus satisfying the requirements of 35 U.S.C. § 112, second paragraph. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

The Examiner has also rejected claim 25, contending that it is unclear what is the “catalytic activity,” so that it is unclear how a change or absence of a change in catalytic activity can be monitored. Applicant disagrees. The specification defines the term “catalytic activity” on page 14, lines 15-26. Based on this definition, the ordinarily skilled artisan would be reasonably apprised of the scope of the invention with regard to the term “catalytic activity.” Nevertheless, in an effort to advance prosecution, Applicant has amended claim 25 herein to clarify the term “catalytic activity.”

The Examiner has also rejected claim 26, contending that it is unclear as to what is meant by an “interaction,” so that it is unclear how a change or absence of a change in interaction can be monitored, and that it is not clear as to what is meant by a “natural binding partner.” Applicant respectfully traverses this rejection.

Claim 26, as amended herein, refers to an interaction between a C-RET receptor protein and a natural binding partner of C-RET. With respect to the phrase “natural binding partner,” the skilled artisan would understand that this term refers to one or more molecules that naturally occur within a cell and that specifically bind to C-RET. As discussed above, examples of natural binding partners are discussed in the specification on page 7, lines 19-24, and on page 14, line 27, through page 16, line 5. The ordinarily skilled artisan would understand that C-RET and a binding partner “interact” due to the

specific binding affinity of C-RET for that binding partner, as discussed in the specification, for example on page 7, lines 19-24, and on page 14, line 27, through page 16, line 5.

Accordingly, the instant claims, when read in light of the specification, reasonably apprises those skilled in the art of the scope of the invention with regard to the interaction of C-RET with a natural binding partner, thus satisfying the requirements of 35 U.S.C. § 112, second paragraph. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

*Art-Related Remarks*

35 U.S.C. § 102

The Examiner has rejected claims 23-26 under 35 U.S.C. § 102(a) as allegedly being anticipated by Trupp *et al.*, Nature 381:785-789 (1996), and by Durbec *et al.*, Nature 381:789-793 (1996), contending that each reference describes expressing C-RET in cells, contacting the cells with the natural binding partner GDNF, and monitoring the resulting phenotype. Paper No. 9, paragraphs 4 and 5. Applicants respectfully traverse this rejection.

In order to anticipate a claim, a single prior art reference must provide each and every element set forth in the claim. Furthermore, the claims must be interpreted in light of the specification. *In re Bond*, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990); *see also* MPEP § 2131.

The claims, as amended herein, describe contacting cells with compounds selected from the group consisting of peptides of less than 20 amino acids, non-peptide organic molecules, and antibodies. GDNF does not fall within any of these classes of compounds. Therefore, because neither of the cited references describe contacting cells with peptides of less than 20 amino acids, non-peptide organic molecules, or antibodies, the claimed invention is not anticipated by either Trupp *et al.* or Durbec *et al.*

Accordingly, Applicant respectfully requests that the rejection be reconsidered and withdrawn.

### CONCLUSION

In view of the above amendments and remarks, Applicant respectfully submits that the pending claims are in condition for allowance. An early notice to that effect is earnestly solicited. Should any matters remain outstanding, the Examiner is encouraged to telephone the undersigned at (858) 720-2500 so that they may be resolved without the need for additional action and response thereto.

Respectfully submitted,  
Brobeck, Phleger & Harrison LLP

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By: Michael Whittaker  
For Richard J. Warburg,  
Michael A. Whittaker  
Registration No. 46,230

12390 El Camino Real  
San Diego, CA 92130  
Telephone: (858) 720-2500